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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,383	02/17/2004	James David Johnston	1999-0214CON	1624
26652	7590	07/02/2007		
AT&T CORP. ROOM 2A207 ONE AT&T WAY BEDMINSTER, NJ 07921			EXAMINER CHAUDRY, MUJTABA M	
			ART UNIT	PAPER NUMBER
			2112	
			MAIL DATE	DELIVERY MODE
			07/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/780,383

Applicant(s)

JOHNSTON ET AL.

Examiner

Mujtaba K. Chaudry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-55 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/16/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicants' preliminary amendment was received December 18, 2006. Claims 1-26 are cancelled and 27-55 are pending for examination.

#### ***Priority***

Examiner acknowledges priority to application 09660031. The priority date of September 12, 2000 is granted.

#### ***Information Disclosure Statement***

The references listed in the information disclosure statements (IDS) and PTO 892 of application 09660031 submitted were considered. The submission is in compliance with the provisions of 37 CFR 1.97.

#### ***Oath/Declaration***

The Oath filed February 17, 2004 complies with all the requirements set forth in MPEP 602 and therefore is accepted.

#### ***Drawings***

The drawings submitted February 17, 2004 are accepted.

### ***Specification***

The specification submitted February 17, 2004 is accepted.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities:

- The acronym DSE needs to be written out, at least in the first appearance of the claims.

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 27-55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6718507. Although the conflicting claims are not identical, they are not patentably distinct from each other. For example, claim 27 of the present application teaches, a bit stream in computer-readable medium, the bitstream obeying the MPEG-2 or MPEG-4 protocol that permits the transmission of private data in the DSE field of the obeyed protocol, the bitstream generated according to a method comprising: receiving data from a data source; determining syntax information for the data; encoding the data and the syntax information into an encoded bitstream, at least a portion of the syntax information being included in the DSE field and the interpretation of said portion of the syntax information being unspecified by the obeyed protocol; and transmitting the encoded bitstream. Whereas, claim 1 of USPN 6718507 teaches, a method for transmitting data in a bitstream having a plurality of frame portions, the bitstream obeying the ISO/IEC 13818-7, Advanced Audio Coding protocol or the ISO/IEC 14496-3 protocol that permits the transmission of private data in the DES field of the obeyed protocol, the method comprising: receiving data

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from a data source; determining syntax information for the data; encoding the data and the syntax information into an encoded bitstream, at least a portion of the syntax information being included in the DES field and the interpretation of said portion of the syntax information being unspecified by the obeyed protocol; and transmitting the encoded bitstream. The Examiner would like to point out that transmitting data according to certain protocol does not, within of itself, make the claim patentably distinct. One is just an embodiment of the other with obvious variation.


***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Additional pertinent prior arts are included herein for Applicant's review.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mujtaba K. Chaudry whose telephone number is 571-272-3817. The examiner can normally be reached on Mon-Fri 9-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on 571-272-6962.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mujtaba Chaudry  
Art Unit 2112  
June 25, 2007